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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,483	03/01/2004	Michael J. Hurkes	34431	9519
23589	7590	09/05/2006		
HOVEY WILLIAMS LLP 2405 GRAND BLVD., SUITE 400 KANSAS CITY, MO 64108			EXAMINER LEYSON, JOSEPH S	
			ART UNIT	PAPER NUMBER

1722  
DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/790,483

Applicant(s)

HURKES, MICHAEL J.

Examiner

Joseph Leyson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-24 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/08/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's election without traverse of Group II, apparatus claims 9-24, in the reply filed on July 6, 2006 is acknowledged.
2. Claims 1-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 6, 2006.

### *Specification*

3. The amendment filed October 15, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment to paragraph [019] which changes the model number of the cutter; the amendments (both occurrences) to paragraph [023] which change the number of pulses per revolution; and the amendment to paragraph [023] which adds that the blade is raised above the level of the extrudate so that the extrudate can continue. Note that paragraph [023], as originally filed, already discloses that the blade comes up through the table.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the extrudate speed detector being coupled to (or with) the extruder, as recited by claims 9 and 18; the subject matter of claim 15; and the subject

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matter of claim 23. However, note that the rejection, below, under 35 U.S.C. 112, second paragraph, relative to the extrudate speed detector being coupled to (or with) the extruder should be overcome before such subject matter is incorporated into the disclosure.

***Claim Objections***

5. Claims 19 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 19 and 20 only further disclose materials to be worked upon by the claimed apparatus, and does not further recite structure or structural relationships. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). See MPEP 2115.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 18 recite that the extrudate speed detector is coupled to (or with) the extruder which is incorrect. As understood from the specification (i.e., paragraphs [022] and [023]), the speed detector is coupled to (or with) the extrudate so as to be able to detect the extrudate speed.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Duis (U.S. Patent 1,960,773).

Duis (U.S. Patent 1,960,773) teaches an apparatus including an extruder 1, 2 for extruding an extrudate 3, an extrudate speed detector 5 having a speed-indication output, the extrudate speed detector 5 coupled to the extruder 1, 2 through the extrudate 3, and a servo-controlled cutter 23 coupled to the speed-indication output of the extrudate speed detector 5, wherein the cutter 23 travels at substantially the same speed as the extrudate 3 to ensure a straight cut across the extrudate 3 (p. 1, col. 1, to p. 2, col. 2, line 110) (which enables the servo-controlled cutter to cut an inelastic extrudate portion without communicating imperfections to an elastic extrudate portion as

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the extrudate is extruded, as understood from the instant specification). The extruder 1, 2 includes an extrusion die 2 with a generally rectangular cross-sectional configuration (i.e., fig. 1) and/or a hollow-core configuration 65, which configuration is capable of being a railing piece. As to the recitations, such as "for manufacturing composite lumber" and "for extruding initially heated composite materials", such recitations relate to the intended use of the claimed apparatus and are not positively claimed. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); see MPEP 2114.

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). See MPEP 2115.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duis (U.S. Patent 1,960,773) in view of Giles (U.S. Patent 4,088,430).

Duis (U.S. Patent 1,960,773) discloses the apparatus substantially as claimed as mentioned above, except for the extrudate speed detector including an encoder wheel or an optical speed detector, the speed-indication output including a pulse output, or the pulse output being coupled to the servo-controlled cutter using at least one electrical conductor, as respectively recited by instant claims 13-15.

Giles (U.S. Patent 4,088,430) discloses an extrudate speed detector including an encoder wheel 52, an optical speed detector 81, 82, a pulse output having a frequency correlated to the extrusion rate, wherein the pulse output is coupled to a servo-controlled cutter 85 using at least one electrical conductor 84 (i.e., col. 6, lines 9-32).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to replace the speed detector of Duis (U.S. Patent 1,960,773) with the speed detector of Giles (U.S. Patent 4,088,430) because both speed detectors are art recognized alternatives for detecting extrudate speed.

12. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duis (U.S. Patent 1,960,773) in view of Dahl et al. (U.S. Patent 6,153,293).

Duis (U.S. Patent 1,960,773) discloses the apparatus substantially as claimed as mentioned above, except for the cutter being a cutoff saw or a flying knife.

Dahl et al. (U.S. Patent 6,153,293) discloses a cutoff station 32 which includes a cutoff saw or a flying knife for cutting an extrudate (i.e., col. 6, lines 18-24).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to replace the cutter Duis (U.S. Patent 1,960,773) with a cutoff saw or a flying knife because such a cutoff saw and flying knife are an art recognized alternative cutters for cutting extrudate, as disclosed by Dahl et al. (U.S. Patent 6,153,293).

13. Claims 18-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al. (U.S. Patent 6,153,293) in view of Goforth et al. (U.S. Patent 5,088,910) and Duis (U.S. Patent 1,960,773).

Dahl et al. (U.S. Patent 6,153,293) disclose a composite lumber extrusion line for producing composite lumber materials including an extruder 26 operable to produce an extrudate having substantially uniform cross-sectional dimensions, a servo-driven cutter 32 including a movable table or flying knife or cutoff saw (col. 6, lines 18-24), and a spray bath 30 positioned in the extrusion line between the extruder 26 and the servo-driven cutter 32, the spray bath 30 being adapted to cool the extrudate from a heated plastic condition to a cooled hardened condition prior to being cut by the servo-driven cutter 32. The composite lumber materials include cellulose 18. And the extrusion line does not include a puller. However, Dahl et al. (U.S. Patent 6,153,293) does not disclose variable speed extrusion, an extrudate speed detector coupled with the extruder operable to transmit an extrudate speed indication associated with the speed of the extrudate, the servo-driven cutter including a clamp and a table-travel-speed input, or the servo-driven cutter coupled to the extrudate speed detector, wherein the movable table moves in relation to the speed of the extrudate.



Goforth et al. (U.S. Patent 5,088,910) disclose a composite lumber extrusion line for producing composite lumber materials including an extruder 36 operable to produce an extrudate and a servo-driven cutter including a movable table with a table-travel-speed input for changing the table speed to accommodate varying speeds of extrudate flow (i.e., figs. 5-7; col. 11, lines 43-45), clamps 136, 138 and a flying knife 80. The moving servo-driven cutter allows the extrudate to be cut into pieces while it is continuously flowing from the extruder 36 without the extrudate on the upstream side of the knife 80 ramming into the knife 80 as a cut is being made (i.e., col. 10, lines 44-47)

Duis (U.S. Patent 1,960,773) discloses an extrusion line including an extruder 1, 2 for extruding an extrudate 3 at variable speed depending upon consistency (i.e., bulk density) of the extrusion materials (i.e., p. 1, cols. 1-2), an extrudate speed detector 5 having a speed-indication output, the extrudate speed detector 5 coupled to the extruder 1, 2 through the extrudate 3 operable to transmit an extrudate speed indication associated with the variable speed of the extrudate, and a servo-driven cutter 23 coupled to the speed-indication output of the extrudate speed detector 5, wherein the cutter 23 receives the speed-indication output as a travel-speed input to make the cutter 23 travel at substantially the same speed as the variable speed extrudate 3 to ensure a straight cut across the variable speed extrudate 3 (p. 1, col. 1, to p. 2, col. 2, line 110).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the cutter of the extrusion line of Dahl et al. (U.S. Patent 6,153,293) with the servo-driven cutter of Goforth et al. (U.S. Patent 5,088,910) because such a modification would enable the cutter to accommodate varying speeds

of extrudate, as disclosed by Goforth et al. (U.S. Patent 5,088,910), and to further modify the cutter with the extrudate speed detector of Duis (U.S. Patent 1,960,773) because such a modification would further enable the cutter to accommodate a variable speed extrudate such that the cutter moves in relation to the variable speed of the extrudate, as disclosed by Duis (U.S. Patent 1,960,773).

14. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al. (U.S. Patent 6,153,293) in view of Goforth et al. (U.S. Patent 5,088,910) and Duis (U.S. Patent 1,960,773) as applied to claims 18-20 and 22-24 above, and further in view of Giles (U.S. Patent 4,088,430).

Giles (U.S. Patent 4,088,430) discloses an extrudate speed detector including an encoder wheel 52, an optical speed detector 81, 82, a pulse output having a frequency correlated to the extrusion rate, wherein the pulse output is coupled to a servo-controlled cutter 85 (i.e., col. 6, lines 9-32).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further replace the speed detector of Duis (U.S. Patent 1,960,773) with the speed detector of Giles (U.S. Patent 4,088,430) because both speed detectors are art recognized alternatives for detecting extrudate speed.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lemelson (U.S. Patent 3,422,648), Lemelson (U.S. Patent 3,550,203), Maroschak (U.S. Patent 3,843,758) and Proksa et al. (U.S. Patent 5,388,975) are cited as of interest to show the state of the art.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (571) 272-5061. The examiner can normally be reached on M-F 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gupta Yogendra can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JL

  
ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 1800-1722

8/31/06